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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,227	02/19/2004	Charles Edward Akers JR.	2003-0701.01	5201

21972 7590 10/18/2005

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
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LEXINGTON, KY 40550-0999

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/782,227

Applicant(s)

AKERS ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicants' amendment filed 9/30/05 has been fully considered but the amendment has not been entered given that the amendment raises the issue of new matter and would raise new issues that would require further consideration.

Specifically, applicants' have amended claim 1 to recite, "about 4 to about 4.5 percent color pigment having aromatic rings". It is the examiner's position that this phrase fails to satisfy the written description requirement under 35 USC 112 first paragraph since there does not appear to be a written description requirement of the above phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the amendment, applicants point to Table 1 of the present specification. However, while Table 1 provides support for 4.5% magenta pigment, i.e. Pigment Red 122, and 4.5% yellow pigment, i.e. Pigment Yellow 74, there is no support to (i) recite that the color pigment is present in amount of "about" 4.5 percent and (ii) broadly recite that "color pigment" is present in amount of "about 4.5 percent". With respect to (i), it is noted that Table 1 discloses ink comprising 4.5% magenta pigment or yellow pigment and thus, provides support for the recitation of "4.5 percent". However, the Table does not provide support for the recitation of "about" 4.5 percent that includes amounts slightly above and below 4.5 percent for which there is no support in the specification as originally filed. With respect to (ii), it is noted that while Table 1 discloses support for the use of two specific pigments in the amount of 4.5 percent, i.e. 4.5% Pigment Red 122, i.e. magenta pigment, and 4.5% Pigment Yellow 74, i.e. yellow pigment, these two specific embodiments do not provide support for the broad recitation of "color pigment" present in amount of "about 4.5 percent" which encompasses all color pigments

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including for instance, cyan, in amount of “about 4.5 percent” for which there is no support in the specification as originally filed.

Further, the claims as originally filed recited ink comprising “at least about 4 percent color pigment having aromatic ring”. Thus, the amendment would raise new considerations in regards to how the cited prior art would be applicable against the present claims in light of this change.

Additionally, it is noted that even if the amendment were entered, it is the examiner’s position that the claims would not be allowable over the cited prior art and that each of the prior art references, i.e. Sun et al. (U.S. 2004/0127619), Akers, Jr. et al. (U.S. 6,652,634), and Sacoto et al. (U.S. 2004/0102541) would remain applicable against the present claims under 35 USC 102 and/or 35 USC 103 given that Sun et al. (paragraph 33) disclose the use of pigment in a more preferred amount of about 2.5% to about 5% while Akers, Jr. et al. (col.8, lines 52-55) and Sacoto et al. (paragraph 53) each disclose the use of pigment in preferred amount of about 2% to about 6% which each clearly encompasses the claimed amount and thus, would meet the requirements of the amended claim.



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Art Unit 1714

CS
10/13/05